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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

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| IN RE APPLICATION OF | : |
| WEISS, ET AL. | : EXAMINER: ANSARI, TAHMINA N |
| SERIAL NO: 10/598,764 | : |
| FILED: SEPTEMBER 11, 2006 | : GROUP ART UNIT: 2624 |
| FOR: AUTOMATED NEUROAXIS (BRAIN AND SPINE) IMAGING WITH ITERATIVE SCAN PRESCRIPTIONS, ANALYSIS, RECONSTRUCTIONS, LABELING, SURFACE LOCALIZATION AND GUIDED INTERVENTION | : |

PETITION UNDER 37 C.F.R. § 1.182 TO TREAT APPLICATION UNDER 35 U.S.C. § 111

MAIL STOP PETITION
COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Petitioner herein solicits the Director to convert application 10/598,764, which was identified as a national stage application under 35 U.S.C. § 371 to an application filed under 35 U.S.C. § 111(a).

STATEMENT OF FACTS

On September 11, 2006, Petitioner filed a patent application through the patent office's electronic filing system. As shown in the electronic filing system acknowledgement receipt submitted herewith as Exhibit A, that application was submitted as two separate PDF documents, a PDF of drawings having 28 pages, as well as a specification having 40 pages. The specification included a priority claim to PCT 2005/008311. Additionally, the application was accompanied by a fee worksheet, submitted herewith as Exhibit B. A

declaration was subsequently filed on November 21, 2006. A copy of that declaration is submitted herewith as Exhibit C.

There are substantial differences between the application submitted on September 11, 2006, and PCT 2005/008311. For example, the application submitted on September 11, 2006 includes 44 claims, 28 sheets of drawings, listed two joint inventors, and was titled "Automated Neuroaxis (Brain and Spine) Imaging with Iterative Scan Prescriptions, Analysis, Reconstructions, Labeling, Surface Localization and Guided Intervention." By contrast, PCT 2005/008311 included only 12 claims, 19 sheets of drawings, listed only a single inventor, and was titled "Automated Spine Survey Iterative Scan Technique (ASSIST)."

In all of the papers submitted for this application, the applicants indicated that the invention sought to be patented was that disclosed in the application filed September 11, 2006. For example, both the fee transmittal form, and the declaration indicated that protection was sought for an invention titled "Automated Neuroaxis (Brain and Spine) Imaging with Iterative Scan Prescriptions, Analysis, Reconstructions, Labeling, Surface Localization and Guided Intervention." This was also the title of the application listed in the electronic filing system acknowledgement receipt. Similarly, the declaration lists two inventors (consistent with seeking to patent the invention from the specification filed on September 11, 2006) rather than a single inventor (as would be the case if the applicants had sought to pursue a national stage entry of PCT 2005/008311). The fee transmittal also lists the application for patent as having 44 claims (consistent with seeking to patent the invention from the specification filed on September 11, 2006), rather than 12 claims (as would be the case if the applicants had sought to pursue a national stage entry of PCT 2005/008311).

Despite these indications that the applicants did not intend to pursue PCT 2005/008311 as a national stage entry under 35 U.S.C. § 371, the fee transmittal form did

indicate that fees were paid for a national stage entry under 35 U.S.C. § 371. Additionally, the electronic filing system acknowledgement receipt indicated that the application was identified as a U.S. national stage under 35 U.S.C. § 371. Accordingly, there are conflicting indications in the application's file history regarding whether the application should be treated as a national stage application under 35 U.S.C. § 371, or as a U.S. application filed under 35 U.S.C. § 111 which claimed priority from a previously filed PCT application.

During prosecution, the Office has not consistently treated this application as either a national stage entry of PCT 2005/008311, or as an application filed under 35 U.S.C. § 111 which claims priority from a previously filed PCT application. When claim fees were calculated, the Office based that calculation on the claims submitted for the invention titled "Automated Neuroaxis (Brain and Spine) Imaging with Iterative Scan Prescriptions, Analysis, Reconstructions, Labeling, Surface Localization and Guided Intervention," not on the claims from PCT 2005/008311. Similarly, the title of the invention reflected in PAIR and given on the patent application publication is "Automated Neuroaxis (Brain and Spine) Imaging with Iterative Scan Prescriptions, Analysis, Reconstructions, Labeling, Surface Localization and Guided Intervention," and the claims which have been substantively examined are the claims directed to that invention. However, the number of claims included in the patent application publication, as well as the drawings and specification in that publication are those from PCT 2005/008311, not from the application to patent the invention titled "Automated Neuroaxis (Brain and Spine) Imaging with Iterative Scan Prescriptions, Analysis, Reconstructions, Labeling, Surface Localization and Guided Intervention," filed on September 11, 2006.

## REQUESTED RELIEF

Petitioner requests that the Director issue a decision that application 10/598,764 should be treated as an application filed under 35 U.S.C. § 111 claiming priority from a previously filed PCT application.

## DISCUSSION

To claim the benefit of a prior PCT application in a U.S. application filed under 35 U.S.C. § 111, the applicant must file an application as specified in 35 U.S.C. § 111 (i.e., a specification as prescribed by 35 U.S.C. § 112, a drawing as prescribed by 35 U.S.C. § 113, and an oath or declaration as prescribed by 35 U.S.C. § 115) which includes a claim for foreign priority that identifies the prior PCT application by application number, day, month and year of its filing.[1] It is also possible to claim the benefit of a PCT application by entering the national stage from that PCT application under 35 U.S.C. § 371. To enter the national stage under 35 U.S.C. § 371, an applicant is required to file a national fee, a copy of the international application, amendments to the claims made under PCT article 19, and an oath or declaration in compliance with 35 U.S.C. § 115.[2] In this case, the applicants filed an application as specified in 35 U.S.C. § 111 which included a claim for foreign priority that identifies PCT application 2005/008311 by its number, day, month and year of filing. That application included a written description, claims, drawings, and a title which were different from the written description, claims, drawings and title in PCT application 2005/008311. However, according to the acknowledgement receipt generated by the patent office's electronic filing system, the application was identified as a national stage entry under 35 U.S.C. § 371. This is inconsistent with the fact that the application filed by the applicants

[1] 37 C.F.R. § 1.55(a)(1).
[2] 35 U.S.C. § 371(c).

included substantial material that was absent from the PCT application, and with the fact that the applicants specifically stated that they wished to pursue the invention claimed in the new application. Thus, the issue to be resolved is whether, in light of apparently conflicting instructions from the applicant, a filing should be treated as an application under 35 U.S.C. § 111, or a national stage entry under 35 U.S.C. § 371.

Under the relevant regulations, the present application should be treated as an application filed under 35 U.S.C. § 111. 37 C.F.R. § 1.495(g) specifies that, for an application to be treated as a filing under 35 U.S.C. § 371

> The documents and fees submitted under paragraphs (b) and (c) of this section must be *clearly* identified as a submission to enter the national stage under 35 U.S.C. 371. Otherwise, the submission will be considered as being made under 35 U.S.C. 111(a).[3]

In this case, at most, the fees submitted by the applicants appear to have been identified as fees under 35 U.S.C. § 371.[4] However, the documents filed by the applicants were identified as being different from the previously filed PCT application. For example, the fee worksheet and the declaration indicated that the applicants wished to pursue a patent for an invention titled "Automated Neuroaxis (Brain and Spine) Imaging with Iterative Scan Prescriptions, Analysis, Reconstructions, Labeling, Surface Localization and Guided Intervention," rather than simply entering the national stage to pursue the PCT application (which was entitled "Automated Spine Survey Iterative Scan Technique (ASSIST)"). As a result, because the regulations specify that, unless *both* the fees and documents are *clearly* identified as a national stage entry under 35 U.S.C. § 371, the application will be treated as a filing under 35 U.S.C. § 111, the application should have been treated as a filing under 35 U.S.C. § 111, rather than a national stage entry under 35 U.S.C. § 371.

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[3] Emphasis added.
[4] In the fee worksheet submitted on September 11, 2006, the fees submitted were identified as "U.S. National Stage under 35 USC 371 Filing Fees."

The patent office's internal procedures as reflected in the MPEP also specify that, in a situation like the present case, the application should be treated as an application under 35 U.S.C. § 111. In particular, MPEP 1893.03(a) states that: "if there are *any* conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a)."[5] In this case, there are explicitly conflicting instructions in the form of identification of the subject matter for which a patent is sought as being the invention titled "Automated Neuroaxis (Brain and Spine) Imaging with Iterative Scan Prescriptions, Analysis, Reconstructions, Labeling, Surface Localization and Guided Intervention." As a result, in addition to the regulations indicating that the application should be treated under 35 U.S.C. § 111, the MPEP also indicates that, because of the applicant's conflicting instructions, the application should be treated as having been filed under 35 U.S.C. § 111, not 35 U.S.C. § 371.

It is also in the interest of justice for the application to be treated as a filing under 35 U.S.C. § 111, rather than a national stage entry under 35 U.S.C. § 371. In this case, the application submitted on September 11, 2006 includes substantial material that was not found in the PCT priority application. For example, as set forth in the FACTS section, the new application included more drawings, more inventors, and more claims than were included in the PCT application. However, the MPEP specifies that "new matter may not be added to a U.S. national stage application [i.e., a national stage entry under 35 U.S.C. § 371]."[6] Further, the fact that this application was published could prevent the applicant from filing a later application seeking protection for the new material disclosed on September 11, 2006, since the September 11, 2006 filing is part of the current application's file history.[7] As a result, unless this application is treated as a national stage entry under 35 U.S.C. § 111, the

[5] Emphasis added.
[6] MPEP 1895, citing 37 C.F.R. 1.121(f).
[7] *E.g.*, Bruckelmyer v. Ground Heaters, 445 F.3d 1374 (Fed. Cir. 2006).

applicants could be forever barred from obtaining protection for their technology, despite having disclosed it to the public, and satisfying the requirements of 35 U.S.C. § 111. This would be a gross miscarriage of justice, would subvert the patent system's objective of providing an incentive for disclosure, and should be avoided by treating the present application under 35 U.S.C. § 111.

The petition fee set forth in 37 C.F.R. 1.17(f) is attached. The Commissioner for Patents is hereby authorized to charge any deficiency or credit any overpayment of fees to Frost Brown Todd LLC Deposit Account No. 06-2226.

Respectfully submitted,

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